

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
FILING UNDER 35 U.S.C. § 371

In re Patent Application of:	)	
	)	
Italo Pancheri	)	
	)	Examiner: Not Yet Assigned
Application No.: 10/581,574	)	
	)	Art Unit: Not Yet Assigned
Filed: June 2, 2006	)	
	)	
For: SUCTION PUMP FOR LIFTING	)	
EQUIPMENT	)	
_____	)	

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. 1.47(a)

Dear Sir:

Pursuant to 37 C.F.R. 1.47(a), Applicant hereby requests that the Assignee for the above-referenced application, FAMATEC S.p.A., be allowed to continue the above-identified patent application in its respective name and in the name of the refusing sole inventor, Italo Pancheri. Facts in support of this petition are set forth below, and pertinent information is attached hereto.

(1) Italo Pancheri is named as the sole inventor in the above-identified patent application, and is therefore the sole non-signing inventor;

(2) Attached hereto is the Declaration of Lorenzo Zanoni on behalf of the Assignee, along with proof of pertinent facts regarding the refusal of non-signing

inventor Italo Pancheri to join in the above-identified patent application. As noted in attachments to the Declaration of Lorenzo Zanoni, the last known address for Italo Pancheri is:

Frazione Preghena, 114  
38020 Livo, Italy

(3) Also attached hereto is a copy of the employment contract between the inventor, Italo Pancheri, and the Assignee, FAMATEC S.p.A.; and

(4) Also attached hereto is a copy of the "Italian Code of Industrial Property and New Procedural Rules," noting that the rights deriving from an invention are the employer's.


In view of this petition and the attached documents, Applicant requests that the Assignee, FAMATEC S.p.A., be allowed to proceed with the subject patent application in its respective name and on behalf of non-signing inventor, Italo Pancheri.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Dated: November 27, 2007

  
Stephen M. De Klerk  
Reg. No. 46,503

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(408) 720-8300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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EQUIPMENT	)	
_____		

Mail Stop Missing Requirements  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.47

Dear Sir:

I, Mr. Lorenzo Zanoni, hereby declare as follows:

1. I am currently employed by FAMATEC S.p.A., the rightful owner of the present application, U.S. Application Serial No. 10/581,574 filed on June 2, 2006. I am currently a Manager in the Research and Development Department for FAMATEC S.p.A.

2. After the issue of the Notification of Missing Requirements, I tried several times, without success, to contact Mr. Pancheri by telephone in attempts to obtain the signed documents.

3. On August 28, 2007, a registered letter was sent to the inventor, Mr. Italo Pancheri. This letter enclosed a copy of the U.S. Application, Assignment, and Inventor Declaration. A copy of this letter is attached hereto

as Attachment 1. An English translation of this letter is attached hereto as Attachment 2.

4. On August 30, 2007, Mr. Pancheri received the letter and the enclosed documents, as proved by his signature on the registered mail receipt, referred to as the "Advice of Delivery." A copy of the registered mail receipt with Mr. Pancheri's signature is enclosed as Attachment 3.

5. After August 30, 2007 I tried several times, without success, to contact Mr. Pancheri by telephone in attempts to obtain the signed documents.

6. On September 17, 2007, I received a letter (dated September 14, 2007) from Mr. Pancheri requesting that a sworn translation of the documents sent to him on August 28, 2007 from English into Italian. A copy of this letter is attached hereto as Attachment 4. An English translation of this letter is attached hereto as Attachment 5.

7. At the date of signing this Declaration, I have not yet received signed Declaration and Power of Attorney and Assignment forms from Mr. Pancheri.

I believe that I have made diligent efforts to reach the inventor, and that the inventor is unwilling to join in the application for a patent without undue burden on the part of the Assignee, undue cost, and with diligence on the part of Mr. Pancheri.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true;

and that these statements were made with knowledge that willful, false statements and the like may jeopardize the validity of the application, or any patent resulting therefrom.

Respectfully submitted,

Dated: 27-09-2007

Lorenzo Zanoni  
Lorenzo Zanoni  
On behalf of the Assignee, FAMATEC S.p.A.

## ATTACHMENT 1

Mollaro, 28 agosto 2007

Egregio sig.  
PANCHERI Italo  
Frazione Preghena, 114  
38020 - LIVO

RACCOMANDATA R.R.

Oggetto: Domanda di brevetto statunitense nr. 10/581,574 depositata il 2 giugno 2006 originatasi dalla domanda internazionale nr. PCT/EP2004/053216 depositata il 1 dicembre 2004, a sua volta corrispondente alla domanda italiana nr. TO2003A000966 depositata il 2 dicembre 2003 con il titolo "POMPA ASPIRANTE PER APPARECCHI DI SOLLEVAMENTO".

Egregio signor Pancheri,

con la presente siamo ad informarla che, secondo le sue istruzioni, il 2 giugno 2006 è stata depositata all'Ufficio Brevetti Statunitense una domanda di brevetto rivendicante la priorità della domanda italiana nr. TO2003A000966 depositata il 2 dicembre 2003 con il titolo "POMPA ASPIRANTE PER APPARECCHI DI SOLLEVAMENTO" e della successiva domanda internazionale nr. PCT/EP2004/053216 depositata il 1 dicembre 2004, e che a tale domanda di brevetto l'Ufficio Brevetti Statunitense ha assegnato il numero nr. 10/581,574. Copia della domanda di brevetto statunitense è allegata alla presente per sua conoscenza.

Visto che abbiamo finalmente ricevuto dall'Ufficio Brevetti Statunitense il numero seriale della domanda di brevetto sopra menzionata, abbiamo compilato la presente i moduli di "Assignment" e di "Power of attorney" che La preghiamo cortesemente di firmare dove indicato, e di rispedire ai nostri uffici entro il **14 settembre 2007** in modo tale da permetterci di completare le formalità burocratiche concernenti tale domanda di brevetto.

Qualora Lei avesse bisogno di chiarimenti in merito alla documentazione allegata, o fosse per qualsiasi motivo impossibilitato a restituirci i moduli di "Assignment" e di "Power of attorney" entro la data sopra indicata, La preghiamo cortesemente di contattarci telefonicamente in modo tale da risolvere il problema senza alcun onere a suo carico.

RingraziandoLa anticipatamente per la Sua cortese collaborazione, restiamo in attesa di un suo cortese riscontro il prima possibile.

Distinti saluti

Ing. Lorenzo Zanoni

*Lorenzo Zanoni*

## ATTACHMENT 2



## TRANSLATION OF DOCUMENT 2

Mollaro, August 28, 2007

PANCHERI Italo  
Frazione Preghena, 114  
38020 – LIVO

### REGISTERED LETTER WITH ADVICE OF DELIVERY

RE: US Patent Application No. 10/581,574 filed on June 2, 2006  
deriving from International Application No. PCT/EP2004/053216 filed on December 1, 2004  
corresponding to Italian Application No. TO2003A000966 filed on December 2, 2003  
entitled: "SUCTION PUMP FOR LIFTING EQUIPMENT"

Dear Mr. Pancheri,

I inform you hereby that, according to your instructions, on June 2, 2006 a patent application claiming priority of Italian application no. TO2003A000966 filed on December 2, 2003 entitled "SUCTION PUMP FOR LIFTING EQUIPMENT" and of the following international application no. PCT/EP2004/053216 filed on December 1, 2004 was filed with the US Patent Office and that such patent application was given application no. 10/581,574 by the US Patent Office. Copy of the US patent application is enclosed herewith for your knowledge.

In view of the fact that we have finally received the serial number of the above patent application from the US Patent Office, we enclose herewith the Assignment and Power of Attorney forms which we beg you to sign where indicated and to return to our offices on or before September 14, 2007 so as to put us in a position to complete the bureaucratic formalities relating to the above patent application.

Should you need some clarifications in relation to the enclosed documentation or should you be not in a position to return the Assignment and Power of Attorney forms on or before the date indicated above, please contact us over the phone in order to solve the problem without any burden for you.

Thanking you in advance for your kind cooperation, we look forward to hearing from you as soon as possible.

Yours faithfully,

Ing. Lorenzo Zanoni

## ATTACHMENT 3

DOCUMENT 3

ADVICE OF DELIVERY

N. Raccomandata

13017498897-0



## Posteitaliane

SP 502EP 0794 - Mod. 774 - MOD. 04000 (avviso) - St. (1) Ed. 05

Accettazione **RACCOMANDATA**

È vietato introdurre denaro e valori nella raccomandata: Poste Italiane SpA non ne risponde

RICEVUTA

Si prega di compilare a cura del mittente a macchina o in stampatello

DESTINATARIO	DESTINATARIO		
	VIA / PIAZZA		N° CIV.
	C.A.P.	COMUNE	PROV.
MITTENTE	MITTENTE		
	VIA / PIAZZA		N° CIV.
	C.A.P.	COMUNE	PROV.
SERVIZI ACCESSORI RICHIESTI		<input type="checkbox"/> Via aerea <input type="checkbox"/> A.R. <input type="checkbox"/> Assegno € ..... (in cifre)	
Contrassegnare la casella interessata			

Bollo  
Raccomandazione (manuale)

TASSE

Avviso di rice...ento / *Empfangsbestätigung*
☒ Raccomandata  
Einschreiben

☐ Pacco  
Paket

☐ Assicurata  
Versicherte Sendung
Data di spedizione  
Versenddatum

Euro

Dall'ufficio postale di  
Vom Postamt

Numero / Nummer

Destinatario / Empfänger

Via / Straße

C.A.P. / PLZ

PANCHERI FULVIO ITALO  
FR. PREGHENA N° 114  
38020 LIVO (TN)

Firma per esteso del ricevente  
(Nome e Cognome)  
*Vollständige Unterschrift  
des Empfängers*  
(Vor- und Nachname)

Data  
Datum

Firma dell'incaricato alla distribuzione  
*Unterschrift des Beauftragten  
der Postverteilung*

☐ Consegna effettuata ai sensi dell'art. 33 D.M. 09/04/01 / Zustellung gemäß Art. 33 Ministerialdekret 09/04/01  
☐ Invii multipli a un unico destinatario / • Mehrfachsendungen an einen einzigen Empfänger  
☐ Sottofirma rifiutata / • Verweigerung der Unterzeichnung

Bollo dell'ufficio  
di distribuzione  
Stempel des  
Ausgabeamtes

## ATTACHMENT 4

Preghena, 14/09/2007

Spett.le  
FAMATEC S.p.A.  
c.a. ing. Lorenzo Zanoni  
Via Dell'Industria n.15  
Frazione di Mollaro  
38010 Taio (TN)

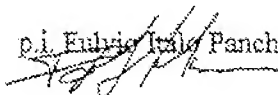
**RACCOMANDATA A/R  
ANTICIPATA VIA TELEFAX**

Oggetto: Domanda di brevetto statunitense nr.10/581,574 depositata il 02.06.2006 e corrispondente alla domanda italiana n. TO2003A 000966 del 02.12.2003 dal titolo "Pompa aspirante per apparecchi di sollevamento"

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In riscontro alla vostra raccomandata del 28.08 u.s., al fine di poter accontentare le vostre richieste, chiedo di farmi avere copia della documentazione allegata in lingua inglese tradotta in italiano. La traduzione dovrà essere asseverata.

Distinti saluti,

p.i.  Fulvio Italo Pancheri

## ATTACHMENT 5

## TRANSLATION OF DOCUMENT 4

*Preghena, 14/09/2007*

FAMATEC S.p.A.  
For the attention of Ing. Lorenzo Zanoni  
Via Dell'Industria, 15  
Frazione di Mollaro  
38010 Taio (TN)

### REGISTERED LETTER WITH ADVICE OF DELIVERY ANTICIPATED BY FAX

RE: US Patent Application No. 10/581,574 filed on June 2, 2006  
corresponding to Italian Application No. TO2003A000966 of December 2, 2003  
entitled: "SUCTION PUMP FOR LIFTING EQUIPMENT"

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In reply to your registered letter of August 28, 2007, in order to satisfy your requests I ask you to let me have a copy of the attached documentation in English language translated into Italian. The translation will have to be a sworn translation.

Yours faithfully,

Fulvio Italo Pancheri

## ONGOING AND COORDINATED COLLABORATION CONTRACT

between

the company FAMATEC s.r.l., with registered office in Taio (TN), Via 4 Novembre no. 21, tax code and VAT number 01219170220, represented here by the legal representative, Mr. Fabrizio

Zambelli, born in \_\_\_\_\_ (\_\_\_\_) on \_\_\_\_\_, resident in \_\_\_\_\_

and

Mr. Pancheri Fulvio Italo, born in \_\_\_\_\_ (\_\_\_\_) on \_\_\_\_\_, resident in \_\_\_\_\_, tax code \_\_\_\_\_.

Whereas

- Mr. Pancheri Fulvio Italo intends to perform ongoing and coordination collaboration at the company FAMATEC s.r.l. as the technical office manager, being responsible, in particular, for the organisation and coordination of the activities of the design office personnel, supervising the entire design process of the mechanical hands and relative gripping tools, dimensional measurement of the product to be handled, identification of the pneumatic components destined for production of the relative plant, checking and approval of drawings, checking on compliance with European safety regulations, management and development of quality control during the design process, and also collaborating with the sales office on the feasibility study into the application requested by the customer and assisting the production department in any requests for technical information on the construction drawings provided; he will also be responsible for research into new products and industrialisation of consolidated products;
- Mr. Pancheri Fulvio Italo expressly declares that the aforementioned professional activity supplied to the company FAMATEC s.r.l. does not form part of the art or profession he normally practises;
- Mr. Pancheri Fulvio Italo declares that he is not required to pay VAT and that therefore, pursuant to art. 5, paragraph 2, of DPR no. 633 of 26.10.1972 and subsequent modifications thereto, his remuneration is not subject to VAT, due to the absence of the subjective requisite for this.

In view of all of the above



it is hereby agreed as follows.

- 1) The company FAMATEC s.r.l. entrusts Mr. Pancheri Fulvio Italo with the task of performing the activities described above according to the methods and terms indicated in art. 2222 of the Italian Civil Code. The professional services provided must be coordinated with the operating requirements of the company FAMATEC s.r.l. They will be performed without any form of subordinate employment and without use by Mr. Pancheri Fulvio Italo of personal operating equipment.
- 2) The monthly remuneration agreed is Lire \_\_\_\_\_ (\_\_\_\_\_), equal to Euro \_\_\_\_\_ (\_\_\_\_\_), payable within the 15<sup>th</sup> of the following month. The remuneration for 2001 is Lire \_\_\_\_\_ (\_\_\_\_\_), equal to Euro \_\_\_\_\_ (\_\_\_\_\_. Said remuneration is intended as including withholding tax, welfare and insurance contributions, to be paid by the collaborator, Mr. Pancheri Fulvio Italo. Mr. Pancheri Fulvio Italo will also be reimbursed for any expenses sustained in performing his activities, on submitting of the relative expenses note.
- 3) This contract comes into effect on 2 May, 2001, and has an unlimited duration, with the possibility of withdrawal by either party with one month's prior notice.
- 4) This contract should only be registered in the case of use and, if so, at the fixed rate according to number 10, part II, of the tariff attached to DPR no. 131 of 26.04.1986.

Read, accepted and signed.

Taio, 23 April, 2001

Fabrizio Zambelli (signature)  
Legal Representative  
FAMATEC s.r.l.  
Via 4 Novembre, 21  
VAT code 01219170220

Fulvio Italo Pancheri (signature)

# CONTRATTO DI COLLABORAZIONE COORDINATA E CONTINUATIVA

Tra

La società FAMATEC S.R.L., con sede in Talo (TN), Via 4 Novembre, n. 21,  
Talo, codice fiscale e partita Iva 01219170220, qui rappresentata dal legale  
rappresentante sig. Zambelli Fabrizio, nato a ( ) il  
residente in

e

Il sig. Pancheri Fulvio Italo, nato ( ) il  
a residente in  
codice fiscale

Premesso che

Il sig. Pancheri Fulvio Italo intende espletare presso la società  
FAMATEC S.R.L., l'attività di collaborazione coordinata e continuativa  
come responsabile dell'ufficio tecnico, in particolare occupandosi  
dell'organizzazione e del coordinamento dell'attività del personale  
dell'ufficio progettazione, sovrintendendo tutto l'iter di progettazione dei  
manipolatori e dei relativi attrezzi di presa, della rilevazione  
dimensionale del prodotto da movimentare, l'identificazione dei  
componenti pneumatici destinati alla produzione degli impianti relativi, la  
verifica ed approvazione dei disegni, il controllo del rispetto delle  
normative di sicurezza Europee, la gestione e lo sviluppo del controllo  
di qualità nell'iter di progettazione, infine collaborando con l'ufficio  
commerciale nello studio di fattibilità dell'applicazione richiesta dal  
cliente ed assistendo la produzione per ogni eventuale richiesta di  
informazioni tecniche in merito ai disegni di costruzione forniti.

Si incarica inoltre dello studio di nuovi prodotti e dell'industrializzazione dei prodotti consolidati.

- il sig. Pancheri Fulvio Italo dichiara espressamente che la suddetta attività professionale prestata alla società FAMATEC S.R.L. non rientra nell'arte o professione esercitata abitualmente;

- il sig. Pancheri Fulvio Italo dichiara di non essere soggetto passivo I.V.A. e pertanto, ai sensi dell'art. 6, comma 2, del D.P.R. 26.10.1972, n. 633 e successive modificazioni, i propri compensi non sono assoggettabili ad I.V.A. per mancanza del presupposto soggettivo;

tutto ciò premesso

si conviene e si stipula quanto segue:

1)

la società FAMATEC S.R.L. conferisce al sig. Pancheri Fulvio Italo l'incarico di svolgere l'attività descritta in premessa con le modalità ed i termini di cui all'art. 2222 del Codice Civile. La prestazione professionale dovrà essere coordinata con le esigenze operative della società FAMATEC S.R.L.

Essa si svolgerà senza vincolo di subordinazione e senza impiego di mezzi operativi da parte del sig. Pancheri Fulvio Italo

2)

Il compenso viene pattuito in mensili Lire (

pari ad €

pagabili entro il giorno 15 del

mese successivo. Per l'anno 2001 il compenso viene congruagliato in Lire

) pari

ad €

il compenso così

determinato è da intendersi al fondo delle ritenute fiscali, previdenziali ed assicurative a carico del collaboratore sig. Pancheri Fulvio Italo.

Al sig. Pancheri Fulvio Italo verrà inoltre riconosciuto il rimborso delle spese sostenute nell'espletamento dell'attività, previa presentazione di relativa nota spese.

3)

Il presente contratto ha decorrenza dal giorno 2 maggio 2001 ed ha durata indeterminata, con possibilità di disdetta con un mese di anticipo da ambo le parti.

4)

Il presente contratto è da registrarsi solo in caso d'uso ed eventualmente a tassa fissa ai sensi del numero 10, parte II della tariffa allegata al D.P.R. 26.04.1985, n. 131.

Letto, accettato e sottoscritto.

Talo, 23 Aprile 2001

Fabrizio Zambelli  
**FAMATEC/s.r.l.**  
Legale Rappresentante  
Via 4 Novembre, 21  
Partita IVA 01219170220

Fulvio Italo Pancheri



# **Le Sezioni Specializzate italiane della proprietà industriale e intellettuale**

*Italian IP Courts Case Law Report*  
*Edizione speciale Special issue*

## **Il codice della proprietà industriale e le nuove regole processuali**

### ***Italian Code of Industrial Property and new procedural rules***

*D.lgs 10 febbraio 2005 n° 30 - D.lgs 17 gennaio 2003 n° 5*



maintaining the European

uent to the dates set forth

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as applicable to patents,  
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first authorisation for the

cate shall not, in any case,  
aches its legal expiration.  
verage of complementary  
provisions, the provisions  
Regulation No. 1768/1992  
ect through a reduction of  
alendar year, starting from  
an legislation.

ecialties outside the patent  
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ary patent coverage of the

## Art. 62 Moral right

1. The right to be recognized as the author of an invention may be exercised by the inventor and, after his death, by his spouse and by his descendants until the second degree, if none, or after their death, by his parents and by the other ascendants and if no such persons, or after their death, by the relatives until the fourth degree.

## Art. 63 Economic rights

1. The rights deriving from industrial inventions, except for the right to be recognized as the author thereof, can be assigned and transferred.
2. The right on industrial invention patents is that of the author of the invention and to his successors in title.

## Art. 64 Employees' inventions

- ① When an industrial invention is made in performance or in execution of a contract or of an employment relationship, whereby the inventive activity is provided for as the object of the contract or of the relationship and for such purpose an employee receives compensation, the rights deriving from such invention are the employer's, subject to the inventor's right to be recognized as the author thereof.
2. If no compensation for the inventive activity is provided for and established, and the invention was made in the execution or fulfilment of a contract or of an employment relationship, the rights deriving from the invention are the employer's, but the inventor, in addition to his right to be recognised as the author thereof, has the right, if the employer obtains a patent, to be granted a fair reward, the amount of which shall be quantified taking into consideration the importance of the protection afforded by the patent to the invention, the tasks carried out and the compensation received by the inventor, as well as of the contribution that the latter has received from the employer's organization.
3. If the conditions set forth in paragraphs 1 and 2 are not met, and the industrial invention at issue falls within the employer's field of activity, the latter shall have the right of first refusal on the exclusive or non-exclusive use of the invention, or on the purchase of the patent, as well as the right to request or purchase, for the same invention, patents abroad against payment of a fee or price, to be established by taking into account the deduction of a sum corresponding to the support that the inventor has received from the employer in order to achieve the invention. An employer may exercise the right of first refusal within three months from receipt of the notice of filing of the patent application. The relationships established through the exercise of the right of first refusal shall automatically terminate if the due compensation is not entirely paid upon expiry of the time limit.

# L'art. 64, 1° comma, c.p.i. (invenzione "di servizio")

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## Art. 64. Invenzioni dei dipendenti.

1. Quando l'invenzione industriale è fatta **nell'esecuzione o nell'adempimento** di un contratto o di un rapporto di lavoro o d'impiego [*non si distingue se pubblico o privato, n.d.r.*], in cui l'**attività inventiva è prevista come oggetto del contratto** o del rapporto e **a tale scopo retribuita**, i diritti derivanti dall'invenzione stessa appartengono al datore di lavoro, salvo il diritto spettante all'inventore di esserne riconosciuto autore.